

REMARKS

The Office Action of April 2, 2004 and the references cited therein have been carefully considered. In view of the foregoing amendments and the following remarks, it is believed that the application is now in condition for allowance.

The application as filed had claims 1-27. In response to a restriction requirement, claims 17-27 were canceled in a previous Amendment. Claim 2 is canceled in the present Amendment, with claims 1 and 3-16 remain pending after the amendments in this response are entered.

The Office Action rejected claims 1-16 as filed. Specifically, claim 1 was rejected under 35 U.S.C. § 102(e) as being anticipated by Rava et al. and by Camacho et al. Claims 1-4 were rejected under § 102(b) as being anticipated by Wong (U.S. Patent 5,539,207). Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wong in view of Dukor (U.S. Patent 5,945,674). The Office Action nevertheless indicated that claims 6-16 would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claim.

In response, applicants have rewritten claim 6 in independent form to include the limitations of claims 1 and 2, as suggested by the Office Action. Accordingly, claims 6-16 should now be allowable.

Applicants have also rewritten claim 1 to include the limitation originally in claim 2, and claim 2 has been canceled. It is submitted that the limitation originally in claim 2 that "the infrared spectral marker is a relatively flat baseline of an infrared band at about 1280 cm^{-1} " is not taught or suggested by the cited references. Specifically, the Wong reference, which was cited for the rejection of claim 2, does not teach or suggest the existence of a

relatively flat baseline of an infrared band at about 1280 cm^{-1} in the infrared spectrum of a malignant tissue sample, or that such a spectral feature may be used as a marker to indicate the presence of pathology such as cancer. In this regard, the absorption spectra shown in Figures 1 and 2 of Wong contain considerable noise and peaks in the region around 1280 cm^{-1} . As a result, no inference can be made from Figures 1 and 2 of the existence of a relatively flat baseline around 1280 cm^{-1} as an indicator of the presence of pathology. Furthermore, even though Wong makes reference to a peak (or sharp band) around 1283 cm^{-1} , that peak is a spectral feature of connective tissue and is not found in either the normal or malignant tissue samples. For instance, Wong states:

The sharp bands at 1030 1204 **1283** , 1318 , and 1339 cm^{-1} in the spectrum of the connective tissue **are not present in the spectra of both the normal and the malignant epithelial tissues.**

Col. 4, lines 8-11 (emphasis added). Thus, the 1283 cm^{-1} band identified by Wong could not be used as a spectral marker to indicate presence of pathology, since it is not found in either the normal or malignant epithelial tissues.

Accordingly, the inventive discovery that a relatively flat baseline of an infrared band at about 1280 cm^{-1} can be used as a spectral marker to indicate pathology is not taught or rendered obvious by Wong. Claim 1 as amended includes this limitation and thus should be allowable. Claims 3-5 depend from claim 1 and should therefore be also allowable.

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the

In re Appln. of Dukor et al.
Application No. 09/996,205

Examiner, a telephone conference would expedite the prosecution of the subject application,
the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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